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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,963	09/16/2003	Lisa Hunting	047689/262682	2687
26158	7590	09/27/2005		
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC P.O. BOX 7037 ATLANTA, GA 30357-0037			EXAMINER SLACK, NAOKO N	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/663,963

Applicant(s)

HUNTTING ET AL.

Examiner

Naoko Slack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 28-37 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 is/are allowed.
- 6) ☒ Claim(s) 14-16, 18-21, 23, 24, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 17, 22 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/16/03; 1/31/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

In view of applicant's election of Group I, claims 1-27 have been examined in this office action. Claims 28-37 are drawn to non-elected invention.

#### ***Claim Objections***

Claims 14 and 18 are objected to because of the following informalities: On page 18, line 9, and on page 19, line 17, "boarders" should be - - borders - -. Appropriate correction is required.

Regarding claim 27, the language between the preamble and portions of the body of the claim are inconsistent. For example, the preamble of claim 23 sets for the subcombination "an apparatus for framing"; however, on page 21, line 9, claim 27 recites "the rearmost surface of the frame is adhered to the mirror" which sets forth a positive relationship between the frame and the mirror and thus appears to claim a combination.

Applicant should note that a claim with a preamble citing a subcombination is considered as being drawn to the subcombination alone. Subsequent language which sets forth a positive relationship between the subcombination and other structure should be changed to "capable of being positioned adjacent" or similar language.

However, if Applicant intended to claim the combination, the language of the preamble should be changed to indicate the combination.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-16, 18-21, 23, 24, 26, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,612,060 to Pearce.

Claim 14:

Pearce discloses a frame (10) for mounting to a mirror (70) wherein a front surface of the mirror faces away from the supporting structure and is for being viewed, the frame comprising: a rear surface for being mounted to the front surface of the mirror at the margin (Figure 4), so that the frame borders at least some of the front while the rear surface of the frame is mounted to the front surface of the mirror at the margin; an opening which the frame extends around, wherein at least some of the front surface of the mirror can be viewed through the opening of the frame while the rear surface of the frame is mounted to the front surface of the mirror at the margin; one or more recesses (31, Fig. 1A) which extend into the frame from the rear surface and that are for at least partially receiving the protruding portions of the fasteners while the rear surface of the frame is mounted to the front surface of the mirror at the margin, so that the rear surface of the frame can be substantially flush with the front surface of

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the mirror while the rear surface of the frame is mounted to the front surface of the mirror at the margin; and an innermost periphery which extends around and is contiguous with the opening, wherein the innermost periphery and the rear surface of the frame intersect at a circumferential edge that extends around and at least partially defines the opening, and the circumferential edge and the rear surface of the frame are substantially within a common plane.

The phrases "for mounting to a mirror... mirror" (page 18, lines 3-7), "for being mounted to the front surface of the mirror... margin" (page 18, lines 8-11), "wherein... margin" (page 18, lines 12-14), and "for at least partially receiving ... margin" (page 18, lines 16-20) comprise statements of intended use which do not further limit the structural features of the claimed invention. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (*Ex Parte Masham*, 2 USPQ F2nd 1647, 1987). Absent a positive recitation of the mirror and fasteners in combination with the frame, it must only be shown that the apparatus is capable of performing in the manner suggested by the intended use. In this case, it is clear that Pearce's frame is capable of being mounted on the peripheral edges of an existing wall mirror, as illustrated in Figure 4.

Claim 15:

Pearce shows that the circumferential edge is distant from and positioned substantially farther inward than the recesses (31, Figure 1A).

Claim 16:

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An outermost periphery of the frame and the rear surface of the frame intersect at an outer circumferential edge of the frame, the outer circumferential edge is distant from and outward of the recesses, and the circumferential edge and the rear surface of the frame are substantially within the common plane (as best seen in Figure 1A).

## Claim 18:

Pearce discloses an apparatus for framing a mirror that is fastened to a supporting structure, wherein a front surface of the mirror faces away from the supporting structure and is for being viewed, the apparatus for framing comprising: a plurality of sidepieces that to form a frame that has a rear surface for being mounted to the front surface of the mirror at the margin, so that the frame borders at least some of the front surface of the mirror, defines an opening through which at least some of the front surface of the mirror can be viewed while the rear surface is mounted to the front surface of the mirror at the margin, defines one or more recesses (31, Figure 1A) which extend into the frame from the rear surface and that are for at least partially receiving the protruding portions of the fasteners, so that the rear surface of the frame can be substantially flush with the front surface of the mirror while the rear surface is mounted to the front surface of the mirror at the margin, and includes an innermost periphery wherein the innermost periphery and the rear surface of the frame intersect at an inner circumferential edge of the frame, the circumferential edge at least partially defines the opening, and the circumferential edge and the rear surface of the frame are substantially within a common plane.

The phrases “for framing a mirror... mirror” (page 19, lines 10-14), “for being connected together to form a frame” (page 19, line 15), and “for being mounted ... margin” (page 19, lines 16-19), and “for at least partially receiving ... margin” (page 19, lines 24-26) comprise statements of intended use which do not further limit the structural features of the claimed invention. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (*Ex Parte Masham*, 2 USPQ F2nd 1647, 1987). Absent a positive recitation of the mirror and fasteners in combination with the framing apparatus, it must only be shown that the apparatus is capable of performing in the manner suggested by the intended use. In this case, it is clear that Pearce's frame is capable of being mounted on the peripheral edges of an existing wall mirror, as illustrated in Figure 4, and that Pearce's frame is capable of being connected together at the mitered joints.

Claim 19:

Each of Pearce's sidepieces has a front surface that is decorative (see contoured profile of element 30, Figure 1A).

Claim 20:

The ends of Pearce's sidepieces are mitered (as best shown in Figure 5).

Claim 21:

Pearce teaches that the sidepiece includes a rear surface having at least one fastening strip (50, 50', and 50" in Figures 1-3, respectively) mounted thereto for mounting the rear surface of the frame to the front surface of the mirror at the margin.

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Claim 23:

Pearce teaches an apparatus for framing a mirror (70), the apparatus comprising: a plurality of sidepieces (10) having ends that are for being respectively joined to one another at joints to form a frame (20), so that the frame: extends around and thereby defines an opening, includes a rearmost surface for being mounted to the mirror, and includes an innermost periphery which extends around and is contiguous with the opening, wherein the innermost periphery and the rearmost surface of the frame intersect at a circumferential edge that extends around and at least partially defines the opening, and the circumferential edge and the rearmost surface of the frame are substantially within a common plane (as best illustrated by the profile section, Figure 1A).

Claim 24:

Pearce teaches that for each sidepiece of the plurality of sidepieces, a rearmost surface of the sidepiece has at least one fastener (50, 50', and 50" in Figures 1-3, respectively) mounted thereto for fastening the sidepiece to the mirror.

Claim 26:

The ends of Pearce's sidepieces are respectively joined to one another at miter joints to form the frame (as best shown in Figure 5).

Claim 27:

The rearmost surface of Pearce's frame is adhered to the mirror (Figure 2A).



***Prior Art Made of Record***

US Patent 5,950,342 to Suesholtz discloses a frame for pictures comprising a rearward surface with adhesive tape for mounting a mirror; however, the rearward surface is not the rearmost surface as stated in some of applicant's claims.

***Allowable Subject Matter***

Claims 17, 22, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-13 are allowed.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose telephone number is (571) 272-6848. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naoko Slack  
Patent Examiner  
Art Unit 3635

NS  
September 20, 2005